

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Reiner KRAFT)
Serial No.: 09/602,490)
Group Art Unit: 2157)
Filed: June 23, 2000)
Examiner: Lashonda T. JACOBS)
For: SYSTEM AND METHOD FOR)
WEB BASED SHARING OF SEARCH)
ENGINE QUERIES)

APPEAL BRIEF

MS – APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appellants' Brief is filed in response to a Final Office Action dated November 30, 2005, a Notice of Appeal dated May 19, 2006, and a Notification of Non-Compliant Appeal Brief dated November 28, 2006. Reconsideration of the Application, withdrawal of the rejections and allowance of the claims are respectfully requested. Reconsideration of the Application, withdrawal of the rejections, and allowance of the claims are respectfully requested.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted or electronically transmitted using the EFS to the U.S. Patent and Trademark Office on 12/20, 2006.

By: Michelle L. Wyss
Applicant, Assignee, or Representative

Signature: 

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines (IBM) of Almaden, NY.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-23 are pending.

Claims 1-23 currently stand rejected in this application.

The Examiner's rejections of claims 1-23 are on appeal.

Attached hereto is an Appendix containing a copy of claims 1-23, which include the claims involved in this appeal.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of November 30, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1, which is involved in this appeal, is directed to a method of sharing queries in a hub processing unit coupled to a plurality of information processing units over a network. This is described at page 2, first paragraph, page 14, second paragraph through page 15, second paragraph and illustrated in FIGs. 1 and 3. The method of independent claim 1 sets forth the following subject matter.

A) receiving a Uniform Resource Locator (URL) string from a first user. This step is described in the specification at page 9, second paragraph and illustrated in FIG. 9 as step 901.

- B) determining if the URL string represents a query. This step is described in the specification at page 9, second paragraph and illustrated in FIG. 9 as step 902.
- C) if the URL string represents a query, performing the sub-steps of:
- i) storing the query in a query database. This step is described in the specification at page 9, third paragraph and illustrated in FIG. 9 as step 903.
 - ii) forwarding the query to a hub processing unit in the event that the first user selects the query for sharing with a second user connected to the hub processing unit. This step is described in the specification at page 9, third paragraph and illustrated in FIG. 11 as the Share Last Query 1102 and Share Past Queries 1104.
 - iii) storing information in an accounting database for awarding the first user for submitting the query for sharing. This step is described in the specification at page 12, second paragraph and illustrated in FIG. 9 as step 904.
 - iv) receiving, from a second user, a selection for one of the stored queries for sharing. This step is described in the specification at page 14, second paragraph and illustrated in FIG. 10 as step 1003.

Independent claim 9, which is also involved in this appeal, is directed to a method of sharing queries in a hub processing unit coupled to a plurality of client information processing units over a network. This is described at page 2, first paragraph, page 14, second paragraph through page 15, second paragraph and illustrated in FIGs. 1 and 3. The method of independent claim 9 sets forth the following subject matter.

- A) Receiving a query selected for sharing by a first user of a client information processing system. This step is described in the specification at page 9, second paragraph and illustrated in FIG. 9 as step 901.
- B) storing the query. This step is described in the specification at page 9, third paragraph and illustrated in FIG. 9 as step 903.
- C) storing information in an accounting database for awarding the first user for submitting the query for sharing. This step is described in the specification at page 12, second paragraph and illustrated in FIG. 9 as step 904.
- D) receiving from a second user a selection of the query shared by the first user. This step is described in the specification at page 14, second paragraph and illustrated in FIG. 10 as step 1003.
- E) activating a hyperlink to request a search result set based upon the second user's selection of the hyperlink. This step is described in the specification at page 13, second paragraph and illustrated in FIG. 5 as step 506.
- F) displaying the search result set for the second user. This step is described in the specification at page 13, second paragraph and illustrated in FIG. 5 as step 507.

Independent claim 14, which is also involved in this appeal, is directed to a client information processing unit coupled via a network with a hub processing unit apparatus for sharing queries. This is described at page 2, first paragraph, page 14, second paragraph through page 15, second paragraph and illustrated in FIGs. 1 and 3. Independent claim 14 sets forth the following subject matter.

- A) an input for receiving a Uniform Resource Locator (URL) string from a first user. This element is described in the specification at page 8, second paragraph, at page 9, second paragraph, and illustrated in FIG. 2 as element 204.
- B) a comparator for determining if the URL string represents a query. This element is described in the specification at page 2, second paragraph, at page 9, third paragraph, and illustrated in FIG. 1 as elements 103a-103x.
- C) an interface for storing the query in an information processing unit memory. These elements are described in the specification at page 17, third and fourth paragraphs.
- D) an output for forwarding the query to a hub processing unit in the event that the first user selects the query for sharing with a second user connected to the hub processing unit. This element is described in the specification at page 8, fourth paragraph, page 14, second paragraph and illustrated in FIG. 2, element 205 and FIG. 10 as step 1003.
- E) an accounting database for storing information for awarding the first user for submitting the query for sharing. This element is described in the specification at page 12, first paragraph and illustrated in FIG. 3 as element 306.
- F) an input for receiving, from a second user, a selection for one of the stored queries for sharing. This step is described in the specification at page 10, second paragraph and illustrated in FIG. 3 as element 307.

Independent claim 21, which is also involved in this appeal, is directed to a server for sharing queries in a client-server network. This is described at page 2, first paragraph, page 14, second paragraph through page 15, second paragraph and

illustrated in FIGs. 1 and 3. Independent claim 21 sets forth the following subject matter.

A) an input means for receiving from a client over a network, a query selected by a first user for sharing. This element is described in the specification at page 8, second paragraph, at page 9, second paragraph, and illustrated in FIG. 2 as element 204.

B) interface means for storing the query received. This element is described in the specification at page 17, third and fourth paragraphs.

C) means for searching through queries by a second user. This element is described in the specification at page 13, second paragraph and illustrated in FIG. 3, element 307.

D) means for finding an interesting shared query by the second user. This element is described in the specification at page 13, second paragraph and illustrated in FIG. 3, element 307 and FIG. 5, steps 502, 503, and 504.

E) means for activating a hyperlink to request a result set if the shared query is of value to the second user. This element is described in the specification at page 13, second paragraph and illustrated in FIG. 3 as step 307.

F) means for awarding the first user for selecting the query for sharing. This element is described in the specification at page 12, first paragraph and illustrated in FIG. 3 as element 306.

G) means for perusing the search result set if the shared query is of value to the second user. This element is described in the specification at page 13, second paragraph and illustrated in FIG. 3 as element 306 and FIG. 5 as step 507.

Independent claim 22, which is also involved in this appeal, is directed to a computer readable medium storing programming instructions including instructions for query sharing in a client server network comprising. This is described at page 2, first paragraph, page 14, second paragraph through page 15, second paragraph and illustrated in FIGs. 1 and 3. A computer readable medium storing programming instructions is described in the specification at page 16, third paragraph through page 17, third paragraph. The method embodied in a computer readable medium of independent claim 22 sets forth the following subject matter.

- A) reception instructions for receiving a Uniform Resource Locator (URL) string from a first user. This step is described in the specification at page 9, second paragraph and illustrated in FIG. 9 as step 901.
- B) determination instructions for determining if the URL string represents a query. This step is described in the specification at page 9, second paragraph and illustrated in FIG. 9 as step 902.
- C) storing instructions for storing the query in a client computer if the URL string represents a query. This step is described in the specification at page 9, third paragraph and illustrated in FIG. 9 as step 903.
- D) forwarding instructions for forwarding the query to a server in the event that the URL string represents a query and the first user selects a query for sharing with a second user connected to the hub processing unit. This step is described in the specification at page 9, third paragraph and illustrated in FIG. 11 as the Share Last Query 1102 and Share Past Queries 1104.

E) storing instructions for storing information in an accounting database for awarding the first user for submitting the query for sharing. This step is described in the specification at page 12, second paragraph and illustrated in FIG. 9 as step 904.

F) receiving, from a second user, a selection for one of the stored queries for sharing. This step is described in the specification at page 14, second paragraph and illustrated in FIG. 10 as step 1003.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-23 are unpatentable over *Culliss* (U.S. Patent No. 6,539,377) in view of *Gormley et al.* (U.S. Patent No. 5,628,004) and further in view of *Walker et al.* (U.S. Patent No. 5,862,223) under 35 U.S.C. §103(a).

VII. ARGUMENT: CLAIMS 1-23 ARE PATENTABLE OVER *CULLISS*, IN VIEW OF *GORMLEY ET AL.*, AND FURTHER IN VIEW OF *WALKER ET AL.*

In the Examiner's Final Office Action of November 30, 2005, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over *Culliss* (U.S. Patent No. 6,539,377) in view of *Gormley et al.* (U.S. Patent No. 5,628,004) and further in view of *Walker et al.* (U.S. Patent No. 5,862,223). The Examiner issued an Advisory Action on March 30, 2006 in response to Appellant's January 30, 2006 Response to the Final Office Action. The Appellants respectfully submit that claims 1-23 are patentable over *Culliss* in view of *Gormley et al.* and further in view of *Walker et al.* under 35 U.S.C. § 103(a).

The Appellants assert that the *Culliss*, *Gormley et al.*, and *Walker et al.* references, taken either alone or in combination with one another, do not teach or suggest the claimed limitations of "receiving a Uniform Resource Locator (URL) string from a first user; determining if the URL string represents a query, if the URL string

represents a query, performing the sub-steps of: storing information in an accounting database for awarding the first user for submitting the query for sharing" as set forth for the presently claimed invention. The cited references also do not teach or suggest: "receiving a query selected for sharing by a first user of a client information processing system" and "storing information in an accounting database for awarding the first user for submitting the query for sharing" as set forth for the presently claimed invention. Furthermore, the cited prior art references do not teach or suggest "an input for receiving a Uniform Resource Locator (URL) string from a first user" and "an accounting database for storing information for awarding the first user for submitting the query for sharing." The cited references also do not teach or suggest "an input means for receiving from a client over a network, a query selected by a first user for sharing" and "means for awarding the first user for selecting the query for sharing" as set forth for the presently claimed invention. Additionally, the cited prior art references do not teach or suggest: "reception instructions for receiving a Uniform Resource Locator (URL) string from a first user" and "storing information in an accounting database for awarding the first user" as is set forth for the presently claimed invention.

Claims 1-8, 10-20 and 22

In the Advisory action of March 30, 2006, issued in response to the Appellant's January 30, 2006 response to the Final Office Action mailed on November 30, 2005, the Examiner stated that "*Walker* discloses experts sharing answers to the other users in which the answers are stored in an expert answer database. Once a user chooses one of the expert answers, the expert is compensated (col. 21, lines 40-44, lines 64-67, and col. 22, lines 1-6). Therefore, *Walker et al.* discloses 'storing information in an accounting database for awarding the first user for submitting the query for sharing'." Advisory Action of March 30, 2006 at page 3. Appellants respectfully traverse this position of the Examiner.

Walker et al. discloses a system for rewarding experts for answering questions submitted by users of a computer system. *Walker et al.*, col. 21, lines 65-67. In *Walker*

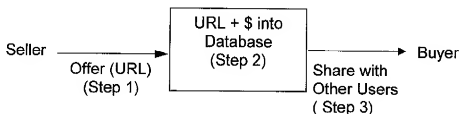
et al., an "end user" submits a request for information to a central controller (200). *Walker et al.*, col. 21, lines 13-14. The central controller generates a price for the end user's request and attaches it to the request. *Id.* Both the end user request and price are then transmitted to a qualified expert as a bid for services. *Walker et al.*, col. 21, lines 18-20. The Expert considers the offered price and, if accepted, the central controller pays the expert for providing an answer. *Walker et al.*, col. 22, lines 51-59. The transaction described in *Walker et al.* does not vary from transactions found in other areas of commerce. In fact, *Walker et al.* merely describes a buyer (the end user) offering, in advance, to pay a price for a service (answering a question) performed by an Expert. This difference is actually stated by the Examiner in the Advisory Action dated March 30, 2006, but does not appear to be recognized by the Examiner. Specifically, the Examiner states that *Walker et al.* discloses "experts sharing answers" and "the expert is compensated." Advisory Action dated March 30, 2006 at page 3. However, the Examiner does not rectify the difference of "answers" in Walker and a query that is in the form of a URL, as recited in independent claim 1 of the instant application.

The present invention, as recited in the independent claims of the instant application, performs the steps of: receiving a Uniform Resource Locator (URL) string from first a user; determining if the URL string represents a query, if the URL string represents a query, performing the sub-steps of: storing information in an accounting database for awarding the first user for submitting the query for sharing.

To more clearly show the distinction between *Walker et al.* and the present invention, the following example is offered. If the *Walker* invention and the present invention were classified ads in the newspaper, the ads would be listed in two different categories. Specifically, the present invention would be in the products section and would be a product (a stored query) advertised for a price (reward to the user for submitting the query). In contrast, the *Walker* invention would be in a services section of ads placed by those that are seeking, and offering to pay, others to perform a desired service (answering questions).

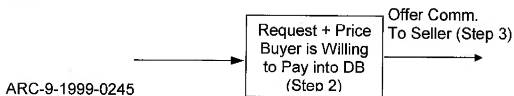
The following drawing is provided to clearly illustrate the distinct differences between the present invention and the *Walker et al.* reference. The present invention provides three steps: 1) a seller (the first user—a person that submits a URL string) shares a URL string that represents a query; 2) the query is stored in a database and points are assigned for awarding the sharing user; and 3) the buyer (second user) selects the stored query.

Present Invention



The following illustration shows the *Walker* invention. As will be explained, not only does *Walker* require an additional step, the steps are out of order of those of the present invention. As an initial distinction, the "Expert" in *Walker et al.* is not the person that submits an advertisement, i.e., URL string/query. The Expert in *Walker* is in fact a person responding to an advertisement, i.e., questions submitted by the end user. The "end user" in *Walker et al.* is most analogous to the "first user" recited in the claims of the instant application. Therefore, as is illustrated below, in the first step of *Walker et al.*, a buyer (end user) requests the performance of a service (answer a question) for a price. In a second step, the question and the request for service (question) and price are placed into a database. The request (question) and the price are communicated to a seller (expert) in a third step for consideration. The seller can decline the request. In the fourth step, the seller performs the service (answers the question).

Walker





The above drawings and description illustrate that the seller (expert) in *Walker et al.* is similar to someone being hired to perform a service at the request of another. Before the seller (expert) can perform the service, however, the service must be specified by an end user. Therefore, the buyer (end user) in *Walker* must act first and specify the service to be performed. In stark contrast, the Seller in the present invention is the one that acts first and shares the query for a price.

Clearly, the subject matter of the *Walker* reference is the answers submitted by the Expert, whereby these answer are used to generate fees from the end users. Accordingly, *Walker* does not "stor[e] information in an accounting database for awarding the [Expert] for submitting the [URL string] for sharing," as recited in independent claims 1, 14, and 22 or "an accounting database for storing information for awarding the first user for submitting the query for sharing" as recited in independent claim 14 of the instant application, because the Expert in *Walker* did not submit the query in the form of a URL string.

Substituting the Expert in *Walker* with the first user in the present invention renders the present invention inoperable. The Expert cannot submit an answer to a question that has not been asked. A person skilled in the art would have had to turn away from the important aspects in *Walker et al.* in order to exchange *Walker's* expert responding to pre-posed questions with a user submitting a URL that is determined to be a query of the present invention. References that produce seemingly inoperative devices cannot serve as predicates for a prima facie case of obviousness.¹

¹ *Michael L. McGinley versus Franklin Sports, Inc.* (Fed Cir 2001) ("If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness."); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

In the Final Office Action dated November 30, 2005, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over *Culliss* (U.S. Patent No. 6,539,377) in view of *Gormley et al.* (U.S. Patent No. 5,628,004) and further in view of *Walker et al.* (U.S. Patent No. 5,862,223). However, as the Examiner correctly recognized on page 3 of that Final Office Action, "*Culliss* in view of *Gormley et al.* does not explicitly disclose storing information in an accounting database for awarding the first user for submitting the query for sharing, as recited in independent claim 1 of the instant application. The Examiner went on to combine *Walker et al.*, which, as explained above, also does not disclose storing information in an accounting database for awarding the first user for submitting the query for sharing.

Consequently, a person skilled in the art would have no suggestion or motivation to combine *Walker et al.* with *Culliss* and *Gormley* as stated by the Examiner. Final Office Action dated November 30, 2005, at page 4. For such a substantial modification of the structure of *Walker*, a motivation would have had to have been necessary which the Examiner would have had to prove with the help of additional relevant prior art references. When there is no suggestion or teaching in the prior art for "determining if the URL string represents a query...and forwarding the query... for sharing" or for "activating a hyperlink to request a search result set upon user selection of the hyperlink" or for "storing information in an accounting database for awarding the first user for submitting the query for sharing" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference *Culliss* taken alone and/or in view of *Gormley et al.* and/or in view of *Walker* does not teach, mention, or even suggest "determining if the URL string represents a query...and forwarding the query... for sharing" or for "activating a

hyperlink to request a search result set upon user selection of the hyperlink" or for "storing information in an accounting database for awarding the first user for submitting the query for sharing"

Additionally, *Gormley et al.*, is not fully analogous to the present invention. *Gormley et al.* discloses a computer system for creating and managing a **local database** and is **not at all internet related**, as is the present invention. In fact, nowhere in the *Gormley et al.* reference do the words "internet," "URL," "HTTP," or "hypertext" appear.

The present invention, in contrast to *Gormley et al.*, is implemented between a web browser and the World Wide Web, i.e., fully web related. Page 9 of the instant application. Independent claims 1, 14, and 22 positively recite that the present invention receives URL strings and determines, by looking within the URL string, whether or not the URL string contains a search query.

To further clarify this distinction, Appellant points to FIGs. 11-13 of *Gormley et al.* and the accompanying text in col. 9, lines 41-57, and col. 10, lines 55-60. A user types query terms directly into fields (shown as boxes) and selects "and"/"or" search options between the boxes. When the execute-query option (block 208) is selected, a computer is programmed to interpret the field selections of the user into what is referred to as a "Structured Query Language" request (block 230) and access to a **database**. It is noted that, *Gormley et al.* never defines the term "Structured Query Language." Regardless, since the entire focus of *Gormley et al.* is searching a local database, URL strings are not taught or disclosed.

Therefore, neither *Culliss* nor *Gormley et al.* teach or suggest *determining if the URL string represents a query, and if the URL string represents a query, performing the sub-steps of: storing the query ...; forwarding the query ... for sharing ...and receiving ... a selection for one of the stored queries ...* as recited in amended independent claims 1, 14, and 22 of the instant application.

Accordingly, claims 1, 14, and 22 distinguish over *Culliss* taken alone and/or in view of *Gormley et al.* and/or in view of Walker for this reason as well.

Claim 9

With regards to independent claim 9, the Appellants refer to the above remarks concerning the lack of a teaching of the claim 1 limitation of "receiving a Uniform Resource Locator (URL) string from a first user; determining if the URL string represents a query, if the URL string represents a query, performing the sub-steps of: storing information in an accounting database for awarding the first user for submitting the query for sharing." Because the cited references do not teach or suggest these limitations, the Appellants assert that there is further no teaching of "receiving a query selected for sharing by a first user of a client information processing system; storing the query; storing information in an accounting database for awarding the first user for submitting the query for sharing; receiving from a second user a selection of the query shared by the first user" as is set forth by independent claim 9. The Appellants also point out that the Examiner has not cited a particular portion of the cited references that teach the limitations of independent claim 9.

Furthermore, independent claim 9 recites "activating a hyperlink to request a search result set upon user selection of the hyperlink". As the Examiner correctly states, *Culliss* does not explicitly disclose "*activating a hyperlink to request a search result set upon user selection of the hyperlink.*" Office Action of June 28, 2005 at page 6.

As stated above, *Gormley et al.* does not disclose any use or connection to the internet. The *Gormley et al.* reference is void of internet related structures or terms. As a result, *Gormley et al.* does not show or suggest "*activating a hyperlink to request a search result set upon user selection of the hyperlink*" as recited in claim 9 of the instant application.

The Appellants hereby submit that to combine *Culliss* with *Gormley et al.*, a motivation would have indeed had to have been present within the references which the

Examiner would have had to prove. A purely general remark towards the combination is insufficient in order to justify a rejection under 35 U.S.C. § 103. In order to establish a prima facie case of obviousness by modifying or combining reference teachings, MPEP § 2143 requires that:

- there must be some suggestion or motivation to combine the references in the prior art;
- there must be a reasonable expectation of success to be found in the prior art; and
- the prior art references must teach or suggest all the claim limitations.

It is submitted that not one of the three criteria has been met.

Furthermore, 35 U.S.C. § 103 demands that obviousness be tested as of the "the time the invention was made." The *Gormley et al.* reference has a filing date of November 18, 1994. In 1994, the internet was in a stage of infancy and not well known or heavily relied upon.² Accordingly, *Gormley et al.* would have not been motivated at the time of invention to implement the invention over an internet, as the internet was not well known. *Culliss* has a later filing date of October 6, 2000. However, and as correctly recognized by the examiner, *Culliss* does not explicitly disclose "a selection for one of the stored queries for sharing in the database" or "capturing search requests for shared queries entered by a second user". Office Action of June 28, 2005 at pages 3 and 6. In other words, *Culliss* did not contemplate sharing queries with other users. Therefore, at the time of invention of *Culliss*, which is internet based, one would have absolutely no motivation to look to *Gormley et al.* for *Gormley's* supposed search result sharing features.

² It wasn't until October 24, 1995, that the Federal Networking Council (FNC) even defined the term "Internet." This definition was developed in consultation with members of the internet and intellectual property rights communities. *The Internet Society* (available at <http://www.isoc.org/internet/history/brief.shtml#fricc>).

Claim 21

With regards to independent claim 21, the Appellants refer to the above remarks concerning the lack of a teaching of the claim 1 limitation of "receiving a Uniform Resource Locator (URL) string from a first user; determining if the URL string represents a query, if the URL string represents a query, performing the sub-steps of: storing information in an accounting database for awarding the first user for submitting the query for sharing." Because the cited references do not teach or suggest these limitations, the Appellants assert that there is further no teaching of "an input means for receiving from a client over a network, a query selected by a first user for sharing...means for searching through queries by a second user...means for awarding the first user for selecting the query for sharing" as is set forth by claim 21. The Appellants also point out that the Examiner has not cited a particular portion of the cited references that teach the limitations of independent claim 21.

Furthermore, independent claim 21 recites "means for activating a hyperlink to request a result set if the shared query is of value to the second user". As the Examiner correctly states, *Culliss* does not explicitly disclose "*activating a hyperlink to request a search result set upon user selection of the hyperlink.*" Office Action of June 28, 2005 at page 6.

As stated above, *Gormley et al.* does not disclose any use or connection to the internet. The *Gormley et al.* reference is void of internet related structures or terms. As a result, *Gormley et al.* does not show or suggest "*means for activating a hyperlink to request a result set if the shared query is of value to the second user*" as recited in claim 21 of the instant application.

The Appellants hereby submit that to combine *Culliss* with *Gormley et al.*, a motivation would have indeed had to have been present within the references which the Examiner would have had to prove. A purely general remark towards the combination is insufficient in order to justify a rejection under 35 U.S.C. § 103. In order to establish a

prima facie case of obviousness by modifying or combining reference teachings, MPEP § 2143 requires that:

- there must be some suggestion or motivation to combine the references in the prior art;
- there must be a reasonable expectation of success to be found in the prior art; and
- the prior art references must teach or suggest all the claim limitations.

It is submitted that not one of the three criteria has been met.

Furthermore, 35 U.S.C. § 103 demands that obviousness be tested as of the "the time the invention was made." The *Gormley et al.* reference has a filing date of November 18, 1994. In 1994, the internet was in a stage of infancy and not well known or heavily relied upon.³ Accordingly, *Gormley et al.* would have not been motivated at the time of invention to implement the invention over an internet, as the internet was not well known. *Culliss* has a later filing date of October 6, 2000. However, and as correctly recognized by the examiner, *Culliss* does not explicitly disclose "a selection for one of the stored queries for sharing in the database" or "capturing search requests for shared queries entered by a second user". Office Action of June 28, 2005 at pages 3 and 6. In other words, *Culliss* did not contemplate sharing queries with other users. Therefore, at the time of invention of *Culliss*, which is internet based, one would have absolutely no motivation to look to *Gormley et al.* for *Gormley's* supposed search result sharing features.

CONCLUSION

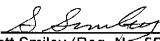
³ It wasn't until October 24, 1995, that the Federal Networking Council (FNC) even defined the term "Internet." This definition was developed in consultation with members of the internet and intellectual property rights communities. *The Internet Society* (available at <http://www.isoc.org/internet/history/brief.shtml#fricc>).

For the reasons stated above, Appellants respectfully contend that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,

Dated: December 21, 2006

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VIII. CLAIMS APPENDIX

Claim 1 (previously presented): A method of sharing queries in a hub processing unit coupled to a plurality of information processing units over a network, the method on the information processing unit comprising the steps of:

- receiving a Uniform Resource Locator (URL) string from a first user;
- determining if the URL string represents a query, if the URL string represents a query, performing the sub-steps of:
 - storing the query in a query database;
 - forwarding the query to a hub processing unit in the event that the first user selects the query for sharing with a second user connected to the hub processing unit;
 - storing information in an accounting database for awarding the first user for submitting the query for sharing; and
 - receiving, from a second user, a selection for one of the stored queries for sharing.

Claim 2 (previously presented): The method as defined in claim 1, wherein the sub-step of forwarding further includes the sub-step of receiving from the second user, a selection of a query from a query history list.

Claim 3 (previously presented): The method as defined in claim 2, wherein the sub-step of forwarding further includes the sub-step of storing information in the accounting

database for awarding the first user for submitting the query in response to the second user selecting the query from the query history list.

Claim 4 (original): The method as defined in claim 1, wherein the determining step further includes the sub-step of analyzing the string for a particular character or characters to determine if the string is a query.

Claim 5 (previously presented): The method as defined in claim 1, wherein the sub-step of forwarding further comprises the sub-step of appending additional information from the first user to the shared query.

Claim 6 (original): The method as defined in claim 5, wherein the appending step further includes appending additional information comprising category, title or descriptive information.

Claim 7 (original): The method as defined in claim 1, wherein the storing sub-step further includes storing the query in an information processing unit wherein the storing is temporary or permanent storage.

Claim 8 (original): The method as defined in claim 1, further comprising a step of repetitively processing incoming strings as long as strings are received from the user.

Claim 9 (previously presented): A method of sharing queries in a hub processing unit coupled to a plurality of client information processing units over a network, the method on the hub processing unit comprising the steps of:

- receiving a query selected for sharing by a first user of a client information processing system;

- storing the query;

- storing information in an accounting database for awarding the first user for submitting the query for sharing;

- receiving from a second user a selection of the query shared by the first user;

- performing the further sub-steps of:

- activating a hyperlink to request a search result set based upon the second user's selection of the hyperlink; and

- displaying the search result set for the second user.

Claim 10 (previously presented): The method as defined in claim 9, wherein the capturing step further comprises capturing searches made through headlines for documents.

Claim 11 (original): The method as defined in claim 9, wherein the receiving step further includes a sub-step of validating a received query string.

Claim 12 (previously presented): The method as defined in claim 9, wherein the receiving step further includes a step of awarding at least one of a reward and points for at least one query submission by a user.

Claim 13 (original): The method as defined in claim 12, wherein the awarding step further comprises notifying an accounting manager of the query submission.

Claim 14 (previously presented): A client information processing unit coupled via a network with a hub processing unit apparatus for sharing queries comprising:

- an input for receiving a Uniform Resource Locator (URL) string from a first user;
- a comparator for determining if the URL string represents a query;
- an interface for storing the query in an information processing unit memory;
- an output for forwarding the query to a hub processing unit in the event that the first user selects the query for sharing with a second user connected to the hub processing unit;
- an accounting database for storing information for awarding the first user for submitting the query for sharing; and
- an input for receiving, from a second user, a selection for one of the stored queries for sharing.

Claim 15 (previously presented): The client information processing unit as defined in claim 14, wherein the input further includes a selection device so that the first user selects a query from a query history list.

Claim 16 (previously presented): The client information processing unit as defined in claim 14, wherein the input further includes a selection device so that the first user selects a query from the received string that has been shown to be a query.

Claim 17 (previously presented): The client information processing unit as defined in claim 14, wherein the comparator includes an analyzer which analyzes the string for a particular character or characters to determine if the string is a query.

Claim 18 (previously presented): The client information processing unit as defined in claim 14, wherein the input further includes a graphical user interface that allows the first user to append additional information to the shared query.

Claim 19 (original): The client information processing unit as defined in claim 18, wherein the graphical user interface further includes a pop-up dialog box that requests additional information comprising category, title or descriptive information.

Claim 20 (original): The client information processing unit as defined in claim 14, wherein the information processing unit memory further includes permanent or temporary memory.

Claim 21 (previously presented): A server for sharing queries in a client-server network comprising:

- an input means for receiving from a client over a network, a query selected by a first user for sharing;
- interface means for storing the query received;
- means for searching through queries by a second user;
- means for finding an interesting shared query by the second user;
- means for activating a hyperlink to request a result set if the shared query is of value to the second user;
- means for awarding the first user for selecting the query for sharing; and
- means for perusing the search result set if the shared query is of value to the second user.

Claim 22 (previously presented): A computer readable medium including programming instructions, the programming instructions including instructions for query sharing in a client server network comprising:

- reception instructions for receiving a Uniform Resource Locator (URL) string from a first user;
- determination instructions for determining if the URL string represents a query;
- storing instructions for storing the query in a client computer if the URL string represents a query;

forwarding instructions for forwarding the query to a server in the event that the URL string represents a query and the first user selects a query for sharing with a second user connected to the hub processing unit;

storing information in an accounting database for awarding the first user for submitting the query for sharing; and

receiving, from a second user, a selection for one of the stored queries for sharing in the database.

Claim 23 (original): The computer readable medium of claim 22, further comprising instructions for selective sharing of URLs.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None.